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United States Court of Appeals for the Federal Circuit

97-1532

PERSONALIZED MEDIA COMMUNICATIONS, L.L.C.,

Appellant,

v.

INTERNATIONAL TRADE COMMISSION,

Appellee,

and

DIRECTV, INC., UNITED STATES SATELLITE BROADCASTING CO.,
HUGHES NETWORK SYSTEMS, and
HITACHI HOME ELECTRONICS (AMERICA), INC.,

Intervenors,

and

THOMSON CONSUMER ELECTRONICS, INC.,
TOSHIBA AMERICA CONSUMER PRODUCTS, INC., and
MATSUSHITA ELECTRIC CORPORATION OF AMERICA,

Intervenors.

DECIDED: January 7, 1999

Before RICH, MICHEL, and LOURIE, Circuit Judges.

RICH, Circuit Judge.

DECISION

Personalized Media Communications, L.L.C. (PMC) appeals from the Final Determination of the International Trade Commission in Investigation No. 337-TA-392 determining that claim 35 of U.S. Patent No. 5,335,277 (the '277 patent) is invalid under 35 U.S.C. § 102(b) because the invention of claim 35 was described in a printed publication and on sale before the critical date. We affirm.

BACKGROUND

The invention disclosed in the '277 patent involves a signal processing system for use in TV broadcasting. The system performs a wide variety of data processing and data communication functions including: detecting, decrypting, and processing of signals embedded in the programming; combining of user specific information with the conventional broadcast programming; the automation of intermediate transmission stations and subscriber stations; and restricting the use of programming to only authorized subscribers. Many of the functions utilize unique codes which are embedded in the transmission of a television program. For example, the written description teaches a system which scans all of the channels until it identifies a particular unique program-identifying code being broadcast over one of the channels and then automatically tunes the television to the station transmitting the unique program-identifying code.

Claim 35 of the '277 patent, the only claim at issue, is directed to a television subscriber station in which a converter, tuner, television receiver or display device, and a controller are combined to provide an automatic tuning feature. The claim is for a

system in which the user can preset a television to automatically tune to a particular television show at a specific time. Claim 35 reads (emphasis added on the single limitation at issue):

> A television subscriber station comprising:
>
> a converter for receiving a multichannel television transmission;
>
> a tuner operatively connected to said converter for selecting a specific television channel;
>
> a television receiver or display device for displaying programming of a channel specified by said tuner; and
>
> a controller operatively connected to said tuner for storing information of a selected television program unit and causing said tuner to select a television transmission containing programming of said television unit at a specific time.

The prior art includes a Programmable Color Television Receiver kit with related accessories, called a Heathkit TV, that can store viewing time and channel information inputted by a user. In operation, the Heathkit TV uses the stored time and channel information to automatically tune itself to the specified channel at the specified time and display whatever TV program is being transmitted over the channel at that time. Manuals describing this product were published before the critical date.

PMC petitioned for relief in the International Trade Commission (Commission or ITC) against the Respondents[1] alleging that the Respondents imported and sold digital satellite system receivers and components that infringed the '277 patent and constituted unfair import trade practices in violation of 19 U.S.C. § 1337(a)(1)(B) (1994). The

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[1] Thompson Consumer Electronics, Inc., Toshiba America Consumer Products, Inc., Matsushita Electric Corporation of America, DirecTV Inc., United States Satellite Broadcasting Company, Inc., Hughes Network Systems, and Hitachi Home Electronics (America), Inc.

Respondents moved for a summary determination that claim 35 of the '277 patent was anticipated by the Heathkit TV and thus invalid under 35 U.S.C. § 102(b). The only issue presented to the ITC was whether the claim limitation "information of a selected television program unit" could include just the time and the channel that a particular television program was to be broadcast or whether the "information" must include a unique program-identifying code. The ALJ concluded that the claim limitation could be satisfied by just channel and viewing time information and entered an Initial Determination that claim 35 of the '277 patent was anticipated by the Heathkit TV and therefore invalid under 35 U.S.C. § 102(b). The Commission denied review of the Initial Determination, upon which the ALJ's Initial Determination became final.

PMC now appeals from the ALJ's summary determination. Essentially, PMC argues that the ALJ improperly construed the claim limitation "information of a selected television program unit." PMC asserts that, properly construed, the limitation requires storage of content information that uniquely identifies a desired unit of television program and that the proper construction of the claim language sustains the validity of Claim 35 over the Heathkit TV. The ITC's jurisdiction over the investigation below was founded on 19 U.S.C. § 1337 (1994). This court's jurisdiction over the appeal is founded on 28 U.S.C. § 1295(a)(6) (1994).

DISCUSSION

The question of whether a summary determination is proper is a question of law. See 19 C.F.R. § 210.18(b) (summary determination is proper "if the evidence of record show[s] that there is no genuine issue as to any material fact and that the moving party is entitled to summary determination as a matter of law"). We review summary

determinations de novo. See Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992).

Claim Construction

The first step in any invalidity or infringement analysis is claim construction. Rockwell Int'l Corp. v. United States, 147 F.3d 1358, 1362, 47 USPQ2d 1027, 1029 (Fed. Cir. 1998). PMC argues that in granting summary determination, the ALJ "failed to construe inferences of the meaning of 'information of a selected television programming unit' supplied by the specification in the light most favorable to PMC." We reject this argument.

As we stated in Cybor, claim construction is a purely legal question. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1455, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (in banc) (stating that questions of construction are questions of law for the judge, not questions of fact for the jury). Claim construction is reviewed de novo on appeal, including any allegedly fact-based questions relating to claim construction. Id. at 1456, 46 USPQ2d at 1174. Thus, there are no facts underlying claim interpretation which must be viewed in the light most favorable to the non-moving party.

In construing a claim, we look first to the intrinsic evidence, consisting of the claims themselves, the written description, and, if in evidence, the prosecution history. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996). Unless the patent clearly states a special definition, words in the claim are to be given their clear and ordinary meaning. Id.

Claim 35 requires a controller for storing "information of a selected television program unit" which can cause the tuner "to select a television transmission containing

programming of the television unit at a specific time." A "selected television program unit" is a particular television program, such as Wall Street Week. The ordinary meaning of the claim phrase is that the controller must store information about a particular television program sufficient to enable the controller to instruct the tuner to display the selected television program. No additional limitation on the type of information is expressly stated or suggested in the claim.

PMC's argument that the doctrine of claim differentiation creates a presumption that "information" of a selected television program unit cannot mean just "channel" and "time" information is not persuasive. It is true that the use of different terms within a claim indicates that different meanings are associated with the terms. However, here "information" does have a different meaning from channel and time. Information is a generic term encompassing different types of information whereas "channel and time" are merely one type of information.

We also reject PMC's argument that functionally claim 35 requires the controller to store information that uniquely identifies the desired television program so that if the desired program is aired on a different channel or at different time, the controller can scan all channels for embedded data signals in order to determine what channel the desired program is on. The claims do not recite any scanning function. Rather, a scanning function requirement is inconsistent with the clear language of the claim which requires that the tuner select a television transmission at a specific time. The use of a scanning function to delay the tuning of a program (such as when a proceeding program, like a sporting event, runs later than expected) would take the system outside

of claim 35's scope since the last clause of the claim requires that the tuning occur at "a specific time".

Neither the written description of the '277 patent nor of U.S. Patent No. 4,694,490 ("the '490 patent"), from which the '277 patent derives priority, provide a definition that alters the plain meaning of claim 35. While examples disclosed in the preferred embodiments may aid in the proper interpretation of a claim term, the particular embodiments appearing in the written description will not be read into the claims when the claim language is broader than such embodiments. Electro Med. Sys. S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054, 32 USPQ2d 1017, 1021 (Fed. Cir. 1994). Here, the written description does not, either explicitly or implicitly, define "information" to mean a unique programming code. The written description does not uniformly use the term "information" with respect to "a selected television program unit" in a way that requires the nonstandard definition that PMC now advocates. Rather, it simply details how the system utilizes the unique program in a single embodiment of the invention.

The written description uses the term "information" as a broad term which embraces many different types of information. For example, the written description uses "meter-monitor information" as a broad term to include different types of information such as "dates and times," "unique identifier codes for each program unit (including commercials)," "unique codes from programming (other than programming identified by program unit codes) whose use obligates users to make payments," "origins of transmissions (e.g., network source stations, broadcast stations, cable head end stations)," and "unique codes that identify the sources and suppliers of computer

data." '277 patent, col. 29:20-41 & 60-61. Similarly, the '490 patent teaches that "input information" can include the cable television system's complete programming schedule, with each discrete unit of programming identified with a unique program code, information about when and where the cable head end facility should expect to receive the programming, and information about when and on which channel or channels the head end facility should transmit each program unit. '490 patent, col. 11:18-30.

While it may be true that the patentees developed and described a system which enables a television subscriber station to automatically tune into a particular television program through the use of a unique program identifier, the claims do not recite a unique program identifier and thus are not so limited. It is the claims of a patent, not the written description, that define the scope of the patentee's right to exclude. See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988).

PMC also asserts that claim 35 cannot be interpreted to read on the Heathkit TV device because two prior art patents, United States Patent Nos. 4,081,753 (the '753 patent) and 4,170,782 (the '782 patent) disclosing devices similar to the Heathkit TV were cited during prosecution. PMC asserts that it was "incumbent upon the ALJ to recognize the importance of and to review thoroughly the prosecution history of the '277 patent as an aid to interpreting claim 35" and that the ALJ's failure to consider the prosecution history should be considered "clear error."

We reject the argument that it is clear error for the ALJ to have failed to thoroughly review each and every document cited in the patent when neither of the parties raises the specific relevance of the cited documents. PMC did not cite the '277

patent's prosecution history to support its claim interpretation either before the ALJ or the Commission in its petition for review. PMC did not specifically mention the '782 or '753 patents below or argue that the patents are relevant for claim construction purposes. To require that the ALJ thoroughly review and consider each of the over 250 references, or risk reversal due to clear error, when the parties themselves do not raise the relevance of the references, is an inefficient use of the ALJ's resources and is not required by our precedent.

Further, review of the prior art patents does not change our claim interpretation. There are over 250 references cited in the '277 patent. Other than the fact that the Examiner initialed the Initial Disclosure Statement, there is no evidence that the Examiner specifically considered the two patents when he allowed claim 35. Indeed, the fact that PMC did not discuss the two patents before the ITC and instead discussed the two patents for the first time on appeal, belies the notion that the two cited patents were considered to be pertinent to an interpretation of the disputed phrase, either by the applicant or the Examiner. Further, PMC has not demonstrated that there are no other limitations in the claim that would distinguish claim 35 over the prior art patents. Thus, we conclude that the prosecution history does not prevent the term "information of a selected television unit" from reading on channel and time information, as provided in the prior art Heathkit TV.

PMC also argues that the Final Determination should be reversed because the ALJ erroneously relied on a claim chart that PMC prepared for settlement negotiations in construing claim 35. We disagree. Even if the ALJ unnecessarily relied on extrinsic evidence when construing the claim, such reliance would constitute harmless error as

we have reached the same claim construction as the ALJ, relying solely on intrinsic evidence.

We therefore hold that the ITC was correct in interpreting the term "information of a selected television unit" as including the channel and time information of a particular television program.

Anticipation

The second step in an anticipation analysis is to determine whether the properly construed claim encompasses the prior art structure. See e.g., Beachcombers, Int'l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1160, 31 USPQ2d 1653, 1658 (Fed. Cir. 1994). A patent is presumed valid. 35 U.S.C. § 282 (1994). As the parties asserting invalidity, respondents at the ITC bore the burden of establishing by clear and convincing evidence facts which support the ultimate legal conclusion of invalidity under Section 102(b). See Checkpoint Sys., Inc. v. Int'l Trade Comm'n, 54 F.3d 756, 761, 35 USPQ2d 1042, 1046 (Fed. Cir. 1995).

For a summary determination of anticipation to be proper, there must be no genuine dispute that the prior art reference discloses each and every limitation of the claim. See Hazini v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997).

As described above, we interpreted the phrase "information of a selected television program unit" to be literally satisfied by channel and time information. PMC does not dispute that the Heathkit TV stored information which identifies the channel and time of a particular television program and causes the television's tuner to tune to the selected television channel at the selected time. PMC also does not dispute that

the remaining claim limitations read on the Heathkit TV. Thus, there is no disputed issue of fact presented as to what is disclosed by the Heathkit TV that can be decided in favor of PMC and summary determination that the Heathkit TV anticipates Claim 35 is proper.

CONCLUSION

Because we conclude that the phrase "storing information of a selected television program unit" can encompass the storage of just channel and time information, and PMC does not dispute that Heathkit TV stores channel and time information or that the Heathkit TV meets the remaining limitations of claim 35, as does the manual, we affirm the ITC's decision.